

**REMARKS**

Applicants acknowledge receipt of an Office Action dated July 18, 2006. In this response Applicants have amended claims 1 and 7. Claim 49 has been added. Following entry of these amendments, claims 1-49 are pending in the application. Support for these amendments may be found in the specification, *inter alia*, at page 9, line 20 to page 10, line 25, in Figure 19 and in Example 1. Claims 14-48 have been withdrawn from consideration as being drawn to non-elected subject matter. Thus, claims 1-13 and 49 are currently pending and under consideration.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

**Claim for Convention Priority**

During a review of their file, Applicants have noted that the PTO has not yet acknowledged acceptance of the Claim for Convention Priority submitted on March 2, 2004. Applicants respectfully request that the PTO acknowledge acceptance of the priority document in its next communication.

**Rejections Under 35 U.S.C. § 102**

On page 2 of the Office Action, the PTO has rejected claims 1-9 and 11-13 under 35 U.S.C. § 102(b) as being anticipated by European Patent 0885937 to Zaima et al. (hereinafter "Zaima"). Applicants respectfully traverse this rejection for the reason set forth below.

Here, Applicants submit that Zaima fails to disclose a resin composition, comprising an oxidized compound having a hydrophobic group "wherein the hydrophobic group is a group -OR bonded to the oxidized compound, in which R represents a non-polarized group" as recited in amended independent claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §102.

### Rejections Under 35 U.S.C. § 103

On page 3 of the Office Action, the PTO has rejected claim 10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zaima. Applicants respectfully traverse this rejection for the reason set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, Applicants submit that Zaima fails to teach or suggest a resin composition, comprising an oxidized compound having a hydrophobic group "wherein the hydrophobic group is a group -OR bonded to the oxidized compound, in which R represents a non-polarized group" as recited in amended independent claim 1 from which claim 10 ultimately depends.

The group -OR in the oxidized compound forms a repulsive force between the group -OR and the thermoplastic resin, and, as a result of the repulsive force, the filler can be dispersed uniformly in the thermoplastic resin. In this regard, Applicants wish to direct the PTO's attention to page 7, lines 2-10 of the present specification.

Applicants note that R does not contain a polar group such as a hydroxyl group or an ether group because when the polar group is added to a major chain of the alkyl group, the alkyl group has polarity as a whole (refer to page 7, line 2-10 of the present specification). If R has polarity as a whole, the repulsive force between the group -OR and the thermoplastic resin becomes insufficient, and this impacts the ability of the filler to be dispersed uniformly in the thermoplastic resin.

In Zaima's reactive particles and process for their production, the reactive particles are represented by the formula (I). The carrier particle A could be any of the organic particles and inorganic particles, the organic groups B1 and B2 are residual of a silane coupling agent

having at least a hydroxyl group. The compound D is a hydrophilic or hydrophobic organic group.

With regard to the PTO's comments regarding experimentation, presuming that the PTO has properly established that varying the amount of oxidized compound is a known, predictable, cause-effective variable (and Applicants do not concede that point here), Applicants note that the PTO has failed to establish a reasonable expectation that experimentation would lead to the claimed range, as opposed, for example, to away from the claimed range.

For these reasons, Applicants submit that the outstanding rejection under §103 is improper and ought to be withdrawn.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §103.

#### **Newly Added Claim 49**

In this response, Applicants have added claim 49. With regard to claim 49, Applicants note that Zaima fails to teach or suggest a resin composition according to claim 1 "wherein a percentage of the polar group other than the hydroxyl group in the oxidized compound is within a range of 80 to 90% based on the whole of the hydroxyl group and the polar group other than the hydroxyl group."

#### **CONCLUSION**

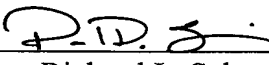
In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16 1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are

needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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